

REMARKS

The Applicant has now had an opportunity to carefully consider the comments set forth in what is believed to be the seventeenth (17th) Office Action to be issued in this application.

A Declaration under 37 CFR §1.131 is being filed herewith with regard to the newly cited primary reference of the Office Action, U.S. Patent Application Publication No. 2002/0083090 by Jeffrey et al. Additionally, the Applicants note that the Office's secondary reference to Saito (U.S. Patent No. 6,353,840) was last cited as an obstacle to patentability in March of 2008, although it was then cited as U.S. Patent Application Publication No. 2001/0042083. In this regard, the attention of the Office is directed to the arguments presented in Applicants' Response L, which was filed on June 4, 2008.

Accordingly, all of the rejections are respectfully traversed. Re-examination and reconsideration are respectfully requested.

The Office Action

In the Office Action that was mailed March 5, 2010:

claims 1, 6 and 7 were rejected under 35 USC §103(a) as allegedly being obvious in view of U.S. Patent Application Publication No. 2002/0083090 by Jeffrey et al. ("Jeffrey"); and

claim 8 was rejected under 35 USC §103(a) as being unpatentable over Jeffrey in view of U.S. Patent No. 6,353,840 to Saito et al. ("Saito").

The Claims Are Not Obvious

Claims 1, 6 and 7 were rejected under 35 USC §103(a) as being unpatentable in view of Jeffrey.

However, Jeffrey is U.S. Patent Application Publication resulting from an application filed on December 27, 2000. It is respectfully submitted that Jeffrey does not claim the subject matter claimed in the present application. A Declaration Under 37 CFR §1.131 showing at least conception prior to December 27, 2000, the filing date of Jeffrey and due diligence from a date prior to said filing date and at least until a

constructive reduction to practice of the subject matter of the present application, is being submitted herewith. Therefore, it is respectfully submitted that Jeffrey is not available as a reference against the claims of the present application.

Said Declaration Under 37 CFR §1.131 was not filed previously because Jeffrey was not cited against the claims of the present application in any previous Office Action.

For at least the foregoing reasons, **claims 1, 6 and 7** are not anticipated and are not obvious in view of Jeffrey.

Claim 8 was rejected under 35 USC §103(a) as being unpatentable over Jeffrey in view of Saito.

However, for the reasons outlined above, Jeffrey is not available as a reference against **claim 8**.

Additionally, the Office Action stipulates that Jeffrey is silent with regard to displaying a plurality of pages on a user interface to select at least one demarcation point on at least one of the pages. In this regard, it is noted that the Office Action only relies on Saito for disclosure of a demarcation point being used as a subsection delimiter. Still further, it is respectfully submitted that Saito does not disclose or suggest the subject matter for which it is relied.

In this regard, it is respectfully submitted that while Fig. 15 of Saito depicts coordinates of elements of a document, it is respectfully submitted that Saito **does not disclose or suggest** that those coordinates be selected from a display of a plurality of pages and used as a demarcation point which in turn is used as a subsection delimiter and searching for items in the document corresponding to the subsection delimiter as is recited in **claims 8 and 7** of the present application.

Indeed, at column 8, lines 30-41, while indicating that this exemplary search template (of cited Fig. 15) includes a user-defined element name, their corresponding coordinates, indentation, font size, font type, as well as a number of lines, the cited paragraph also indicates that the user defined information is limited to a name in this example. While the paragraph cited above indicates that “in an alternative embodiment, other information is provided by an user”, it is respectfully submitted that this is not sufficient to disclose or suggest that a demarcation point, or particular coordinates be selected by a user and used as a defined subsection delimiter as is

recited in **claims 7 and 8**. It is respectfully submitted that only **impermissible hindsight reasoning** based on information gleaned only from the present application would lead one to read such a suggestion into cited Fig. 15 of Saito.

Additionally, it is respectfully submitted that the Office has not met it's burden of presenting a *prima facie* case of obviousness. The Office Action asserts that one would have been motivated to combine "the teachings of Jeffrey et al. with those of Saito et al. to 'permit for locating relevant areas for indexing/bookmarks also based on coordinates/demarcation points, such as though known in advance, to aid in generation of bookmarks/indexes'".

However, this assertion does not explain why one would be motivated to make that combination. It is respectfully submitted that the only motivation is information gleaned only from the present application. Accordingly, the rejection of **claim 8** is based on **impermissible hindsight reasoning**, and **claim 8** is not anticipated and is not obvious in light of Jeffrey and Saito.

Further, the Office Action asserts that "the Examiner notes it would have been obvious to one of ordinary skill in the art for the pages to be displayed in order for the user to view the document to determine criteria to be used."

However, neither Jeffrey nor Saito disclose or suggest such a display. If it was not obvious to Jeffrey et al. or to Saito et al. to provide such a display, it is respectfully submitted that it was not obvious and again, the rejection of **claim 8** is based on impermissible hindsight reasoning and withdrawal thereof is respectfully requested.

For at least the foregoing additional reasons, **claim 8** is not anticipated and is not obvious in light of Jeffrey and Saito.

Telephone Interview

In the interests of advancing this application to issue the Examiner is invited to telephone the undersigned to discuss the foregoing or any suggestions that the Examiner may have to place the case in condition for allowance.

CONCLUSION

Claims 1, 6, 7 and 8 remain in the application. For at least the foregoing reasons, the application is in condition for allowance. Accordingly, an early indication thereof is respectfully requested.

☒ Remaining Claims, as delineated below:

(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT LESS HIGHEST NUMBER PREVIOUSLY PAID FOR		(3) NUMBER EXTRA
TOTAL CLAIMS	4	- 29 =	0
INDEPENDENT CLAIMS	2	- 8 =	0

☒ This is an authorization under 37 CFR 1.136(a)(3) to treat any concurrent or future reply, requiring a petition for extension of time, as incorporating a petition for the appropriate extension of time.

☒ The Commissioner is hereby authorized to charge any filing or prosecution fees which may be required, under 37 CFR 1.16, 1.17, and 1.21 (but not 1.18), or to credit any overpayment, to Deposit Account 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Thomas Tillander, at Telephone Number (216) 363-9000.

Respectfully submitted,

Fay Sharpe LLP

8/3/10

Date



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